

MAY. 30. 2006 1:40PM
TO: USPTO

ZILKA-KOTAB, PC

RECEIVED NO. 3077 P. 1
CENTRAL FAX CENTER

ZILKA-KOTAB
PC
ZILKA, KOTAB & FEECE™

MAY 30 2006

100 PARK CENTER PLAZA, SUITE 300
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
FAX (408) 971-4660

FAX COVER SHEET

Date: May 30, 2006	Phone Number	Fax Number
To: Board of Patent Appeals		(571) 273-8300
From: Kevin J. Zilka		

Docket No.: NAIIP275/01.014.01

App. No: 09/921,543

Total Number of Pages Being Transmitted, Including Cover Sheet: 16

Message:

Please deliver to the Board of Patent Appeals.

Thank you,
Kevin J. Zilka

☒ Original to follow Via Regular Mail ☒ Original will Not be Sent ☐ Original will follow Via Overnight Courier

The information contained in this facsimile message is attorney privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone (if long distance, please call collect) and return the original message to us at the above address via the U.S. Postal Service. Thank you.

IF YOU DO NOT RECEIVE ALL PAGES OR IF YOU ENCOUNTER
ANY OTHER DIFFICULTY, PLEASE PHONE Erica
AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE

May 30, 2006

MAY. 30. 2006 1:40PM

ZILKA-KOTAB, PC

RECEIVED
CENTRAL FAX CENTER

NO. 3077 P. 2

MAY 30 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Vigue et al.

Application No. 09/921,543

Filed: August 2, 2001

For: SYSTEM AND METHOD FOR SECURE
AND VERIFIED SHARING OF RESOURCES
IN A PEER-TO-PEER NETWORK
ENVIRONMENT

)
)
) Art Unit: 2131
)
) Examiner: Henning, Matthew T.
)
) Date: May 30, 2006
)
)
)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

REPLY BRIEF (37 C.F.R. § 41.37)

This Reply Brief is being filed within two (2) months of the mailing of the Examiner's Answer mailed on March 28, 2006.

Following is an issue-by-issue reply to the Examiner's Answer.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

" deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date:

5/30/06

FACSIMILE

✓ transmitted by facsimile to the
Patent and Trademark Office (571) 273-8200.

Signature

Erica L. Farlow

(type or print name of person certifying)

Issues #1-2:

Per the Examiner's Answer dated 3/28/2006, the rejections correlating with Issues #1-2 have been withdrawn.

Issue #3:

The Examiner has rejected Claims 1, 4-7, 15 and 18-25 under 35 U.S.C. 103(a) as being unpatentable over Peng, U.S. Patent No. 6,317,754, in view of Delaney, U.S. Patent No. 6,374,289.

Group #1: Claims 1, 4, 5, 15, 18, 19 and 22-25

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned references, the Examiner argues that it would have been obvious to employ the teachings of Delaney in the synchronization system of Peng by broadcasting the request for each object to a plurality of peers and receiving the requested object from one of the peers. To the contrary, appellant respectfully asserts that it would not have been obvious to combine the teachings of the Delaney and Peng references, especially in view of the vast evidence to the contrary.

Specifically, Peng relates to synchronizing servers, while Delaney relates to distributing data packages among peer clients. To simply glean features from a system for synchronizing servers, such as that of Peng, and combine the same with the *non-analogous art* of data package distribution among peer clients, such as that of Delaney, would simply be improper. Synchronizing servers, as in Peng, allows for a pair of servers to exchange data such that each resultant server contains the same data. On the other hand, distributing data packages among peer clients merely allows for data packages to be requested from peers to other peers where such other peers may respond to the request and only the requested data packages may be downloaded.

"In order to rely on a reference as a basis for rejection of an appellant's invention, the reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems synchronizing servers address as opposed to distributing data packages among peer clients, the Examiner's proposed combination is inappropriate.

In the Advisory Action dated 8/17/2005, the Examiner has argued that both "Peng and Delany belong to the analogous art of data transfer to a device." The Examiner has further argued that simply because Peng and Delaney transfer data to devices in different manners does not classify them as non-analogous art. Appellant respectfully disagrees. In particular, synchronizing servers, as in Peng is not analogous to package distribution among a plurality of peer clients, as in Delaney. Clearly, synchronizing servers does not allow for specific requests/broadcasts to be made as does peer distribution. In addition, synchronization requires a complete transfer of data such that the two systems being synchronized contain identical data as a result of the synchronization, whereas peer distribution allows for only a single requested piece of data to be transferred without necessarily requiring any additional transfers of data.

In the Examiner's Answer dated 3/28/2006, the Examiner has again argued that "both [the Peng and Delancy] references belong to the analogous art of transferring data objects to a device" and that "[t]he differences between the references do not render them as non-analogous art." Specifically, the Examiner has argued that "appellant's assertion that Peng is not related to the art of distributing data packages is incorrect as Peng clearly discloses distributing data packages from one device to another in Col. 6, lines 18-21."

First, contrary to the Examiner's latest assertions, appellant respectfully asserts that the differences between the references do indeed render them non-analogous, especially since such differences are specific to the problems that they address, respectively. The court has specifically found that, regarding an analogy amongst arts, "the similarities and differences in structure and function of the inventions ... carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

Further, it appears that the Examiner has simply broadened a description of the respective arts to the point that they are similar. Appellant respectfully disagrees with such approach. First, such approach may be applied to any art, in that, by sufficiently broadening a description thereof, all arts have some similarities. More importantly, such approach does not take into consideration the significant differences in functionality. Again, appellant respectfully asserts that Peng is not analogous to package distribution among a plurality of peer clients, as in Delaney, since Peng only allows for synchronization between two servers. Clearly, the differences between peer-to-peer frameworks and server-server communications are paramount in nature, thus rendering them *non-analogous*.

In addition, the Examiner has argued that "Delaney recognized that when data is only distributed from one server the server can become overloaded and proposed a solution involving peer-to-peer distribution...Col. 1 Lines 16-35 and Col. 7 Paragraph 2)." However, appellant points out that Delaney merely relates to "data package distribution...[where] each peer client preferably obtains data packages

from other peer clients, rather than obtaining data packages from the external server” (see Abstract). Again, appellant respectfully asserts that Peng is not analogous to package distribution among a plurality of peer clients, since Peng only relates to synchronizing servers.

Furthermore, the Examiner has stated that appellant’s argument that “synchronizing servers...does not allow for specific requests/broadcasts to be made” is in fact not the case because “Peng clearly provides specific requests from a first server to a second server in the form of identifiers representing objects...Cols. 5-6 Step 3.” Appellant respectfully asserts that, in Peng, a request from a second server is made in response to a summarizing version vector sent to it by a first server (note Col. 5, Step 1), thus enabling synchronization of the two servers. However, in Delaney, a requesting peer client broadcasts a request to multiple peer clients located in the peer-to-peer network (see Col. 5, lines 64-67 and Figure 2B). Therefore, synchronizing servers does not allow for specific requests/broadcasts to be made in the manner taught by Delaney. Yet again, appellant respectfully asserts that Peng is not analogous to package distribution among a plurality of peer clients, since Peng only relates to synchronizing servers.

More importantly, with respect to the third element of the prima facie case of obviousness, the Examiner has relied on step 6a in Col. 6 of Peng to make a prior art showing of appellant’s claimed technique of “verifying the retrieved resource by ensuring the retrieved resource contains the version identifier embedded therein” (see this or similar, but not identical language in each of the foregoing claims). Appellant notes that such excerpt in Peng merely teaches verifying that a received object “has a version identifier or time stamp older than or equal to the version vector of the corresponding object in the first [receiving] server.”

However, such version identifier/time stamp is only verified by making sure it is newer than the version already contained at the receiving server, and is not verified to ensure it “contains the version identifier embedded therein,” where the version identifier is contained in a request for a resource by a requesting peer, in the context claimed by appellant.

In the Advisory Action dated 8/17/2005, the Examiner has further argued that Peng clearly discloses "if the received object or update has a version vector or time stamp older than or equal to the version vector of the corresponding object in the first server" and that the version vector is the version vector in the request disclosed in Col. 5, step 1 of Peng. Appellant notes that such excerpt clearly discloses that the version vector of the received object is verified for a second time. Specifically, Peng teaches that first, all objects are identified which exist in a second server, but not in a first server (Col. 5, step 3a). Then, version vectors of such objects are compared to determine if they are newer than version vectors in the first server (Col. 6, step 4). The first server then receives the objects with newer version vectors (Col. 6, step 6) and, after receiving such objects, the first server again compares the version vectors of the received objects with the version vectors of objects already present in the first server such that received objects with older version vectors are thrown away (Col. 6, step 6a).

Clearly, Peng teaches a first receiving server that compares version vectors two times, once before receiving objects and once after receiving the objects. Appellant, on the other hand, claims "verifying the retrieved resource by ensuring the retrieved resource contains the version identifier embedded therein" (emphasis added). Thus, appellant claims verifying a resource by ensuring the retrieved resource has the originally requested version identifier embedded therein, whereas Peng only teaches comparing versions vectors for a second time and taking any newer version, regardless of whether it was an originally requested resource. In this way, Peng does not allow for the receiver of the resource to be able to verify that a specifically requested resource is in fact the same resource received.

In the Examiner's Answer dated 3/28/2006, the Examiner has again relied on Peng's disclosure that "[i]f the received object or update has a version vector or time stamp older than or equal to the version vector of the corresponding object in the first server..." in arguing that "Peng does check (verify) that the version vector in the request matches the version vector in the received object." First, appellant points out that such excerpt in Peng relates to comparing the version vector of a received

object with a version vector of a “corresponding object in the first server” (see specifically Col. 6, lines 54-57). Thus, Peng compares a version vector of a received object with a version vector located within an already held object. Simply nowhere do the cited excerpts from Peng even suggest that “the request contains an identification of the resource and the resource identification contains a resource version identifier” where “the retrieved resource [is verified] by ensuring the retrieved resource contains the version identifier embedded within” (emphasis added), and thus the version identifier contained in the request, in the context specifically claimed by appellant.

Further, since Peng relates to the *non-analogous* art of server-server synchronization, it would be *unobvious* to incorporate applicant’s claimed request inclusive of the resource version identifier, since such feature is particularly suited for applicant’s claimed peer-to-peer environment where it is not necessarily known which of a plurality of peers has the requested resource.

Still yet, appellant respectfully points out that in Peng “[i]f the received object or update has a version vector or time stamp older than or equal to the version vector of the corresponding object in the first server, this object or update will be thrown away” (Col. 6, step 6a-emphasis added). Thus, since, in Peng, the object is thrown away if the version vector of the received object is equal to the version vector of the already held object; Peng clearly such *teaches away* from appellant’s claim language of “verifying the retrieved resource by ensuring the retrieved resource contains the version identifier embedded within” (emphasis added).

Appellant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness have not been met, since it would be *unobvious* to combine the references, as noted above, and the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claims 6 and 20

The Examiner has relied on step 3 in Cols. 5-6 of Peng to make a prior art showing of appellant's claimed technique of "comparing the listing of resources with resources installed at the requesting peer to determine which resources are to be requested over the peer-to-peer network."

Appellant respectfully asserts that such excerpt merely relates to synchronizing two servers, and not "determin[ing] which resources are to be requested over the peer-to-peer network" (emphasis added).

In the Advisory Action dated 8/17/2005, it seems the Examiner has relied on paragraph [0064] and [0098] in Radatti to meet appellant's specific claim language. However, appellant notes that the Examiner did not reject Claim 6 et al. under the Radatti reference. Appellant again emphasizes that the Peng reference does not meet appellant's specific claim language for the reasons noted above.

In the Examiner's Answer dated 3/28/2006, the Examiner has again argued that Step 3 in Cols. 5-6 of Peng teaches "the first server determines which resources will be requested." Specifically, Peng discloses that "[u]pon receiving the summarizing version vector and identifiers from the second server, the first server figures out all of the identifiers of objects which need to be received as whole objects and sent to the second server" (emphasis added).

However, receiving the summarizing version vector and identifiers from the second server to determine which identifiers of objects to send to the second server simply fails to disclose a technique of "comparing the listing of resources with resources installed at the requesting peer to determine which resources are to be requested over the peer-to-peer network" (emphasis added), as claimed by appellant. In addition, the Examiner argued that "the arguments against the references individually, when the rejection was based on a combination of references, was not found persuasive." However, Peng, in combination with Delaney, still fails to even suggest a technique of "comparing the listing of resources with resources installed at the requesting peer to determine which resources are to be requested over the peer-to-peer network" (emphasis added), as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claims 7 and 21

The Examiner has relied on Col. 7, lines 13-18 in Delaney to make a prior art showing of appellant's claimed technique of "requesting each resource to be requested in a separate transaction such that each resource to be requested may be retrieved from a same or different responding peer."

Appellant notes however, that the excerpt relied on by the Examiner relates to a single data package. Appellant respectfully asserts that in fact, Delaney *teaches away* from appellant's claim language since Delaney discloses that "[o]ptionally and preferably, if more than one data package is desired, a list of requested data packages is included in the request message rather than a single MD5 digest, in order to reduce the total number of request messages on the network" (see Col. 7, lines 22-25).

In the Advisory Action dated 8/17/2005, the Examiner has argued that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, appellant respectfully asserts that the excerpt from Delaney relied on by the Examiner (in combination with those excerpts cited in Peng) simply does not meet appellant's specific claim language. In particular, appellant claims "requesting each resource to be requested in a separate transaction such that each resource to be requested may be retrieved from a same or different responding peer" (emphasis added). The excerpt in Delaney relied on by the Examiner simply relates to when a single data package is desired. However, Delaney further teaches that "if more than one data package is desired, a list of requested data packages is included in the request message rather than a single MD5 digest, in order to reduce the total number of request messages on the network" (see Col. 7, lines 22-25-emphasis added). Clearly, creating a list of requested data

packages when more than one data package is desired, as taught by Delaney, does not meet appellant's specific claim language.

In the Examiner's Answer dated 3/28/2006, the Examiner argued that the key word "[o]ptionally" "makes no requirement that a list be sent out, but rather states that it is optional." However, whether or not Delaney teaches such feature as being an option or not, such teaching simply fails to suggest a technique of "requesting each resource to be requested in a separate transaction such that each resource to be requested may be retrieved from a same or different responding peer" (emphasis added), as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue #4:

The Examiner has rejected Claims 2 and 16 under 35 U.S.C. 103(a) as being unpatentable over Peng, U.S. Patent No. 6,317,754, in view of Delaney, U.S. Patent No. 6,374,289, in further view of Shostack, U.S. Patent No. 6,298,445.

Group #1: Claims 2 and 16

Appellant respectfully asserts that such claims are not met by the prior art for the reasons argued above with respect to Issue #3, Group #1.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue #5:

The Examiner has rejected Claims 3 and 17 under 35 U.S.C. 103(a) as being unpatentable over Peng, U.S. Patent No. 6,317,754, in view of Delaney, U.S. Patent No. 6,374,289, in further view of Shostack, U.S. Patent No. 6,298,445, in further view of Verisign (Verisign Gets US Approval for 128-bit Key Certificates Export).

Group #1: Claims 3 and 17

Appellant respectfully asserts that such claims are not met by the prior art for the reasons argued above with respect to Issue #3, Group #1.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue #6:

The Examiner has rejected Claims 8 and 11 under 35 U.S.C. 103(a) as being unpatentable over Radatti, U.S. Patent Application Publication 2002/0170052, in view of Delaney, U.S. Patent No. 6,374,289.

Group #1: Claims 8 and 11

The Examiner has relied on paragraphs [0093-0094] in Radatti to make a prior art showing of appellant's claimed technique of "verifying each retrieved resource by ensuring the retrieved resource contains the version identifier embedded therein."

Appellant respectfully asserts that such excerpts in Radatti only teach determining if a "server target file hash does not match the client entry in the update_index file." Appellant notes that Radatti, in fact, only teaches that the "update software obtains the update_hash file from the server, which [is] compared to the client update_hash file...[and if] another version of the software product is available, the hash is different, and the update program [proceeds] to download update_index from the server" (see paragraph [0083]). Thus, update_index is only downloaded if it is

verified that the hash is different, and each retrieved resource is not verified in Radatti “by ensuring the retrieved resource contains the version identifier embedded therein,” as claimed by appellant.

In the Advisory Action dated 8/17/2005, the Examiner has stated that paragraph [0003] in Radatti teaches that “version information in the received resource is hashed and compared with a hash of the version information of the server copy of the resource.” Appellant respectfully disagrees. First, such excerpt from Radatti only teaches that when hash information is compared between a client and a server, such comparison can also be used to ensure file integrity on the client. However, nowhere in Radatti are retrieved resources verified, let alone in the specific context claimed by appellant. Second, file integrity is determined during comparison of hashes, and not for retrieved resources. Third, only the file integrity is determined in Radatti, and not whether a retrieved resource contains a requested version identifier embedded therein, in the manner claimed by appellant. Thus, clearly such excerpt does not meet appellant’s specific claim language.

In the Examiner’s Answer dated 3/28/2006, the Examiner has argued that “[i]n the description of a module which was downloaded to the client from the server (See Paragraph 0087) a ‘hash of the module...will be used by update manager to verify that the module was not corrupted in transmission’.” The Examiner has further argued that the “only description of how to use this hash is in paragraph [0093].” Still yet, the Examiner has stated that in paragraph [0087] “the version identifier is included in the module...[and] is also found in the server ‘update_index’” and that because “the hash of the module is verified, and the hash included the version identifier, the version identifier in the module was inherently verified.”

Appellant respectfully asserts that, in Radatti, hashes of a downloaded module version and a client update_index file are compared (see paragraph [0094]). Clearly, comparing a hash of a downloaded version of a module to a hash in a client update_index file does not even suggest appellant’s specific claim language. In particular, the client update_index file in Radatti merely relates to an index of files located on a computer system that are subject to updates (see paragraph [0034]).

Thus, simply nowhere does Radatti specifically teach a "request [that] contains...a resource version identifier" where "each retrieved resource [is verified] by ensuring the retrieved resource contains the version identifier embedded therein," and thus the version identifier contained in the request, in the context claimed by appellant.

To emphasize, Radatti only teaches comparing a hash of a downloaded module to a hash of an update_index file, and thus does not even suggest making any sort of comparison with respect to a version identifier contained in a request. Also, appellant respectfully asserts that Radatti only relates to verifying file integrity, but does not even suggest determining whether a retrieved resource contains a requested version identifier embedded therein, in the manner claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue #7:

The Examiner has rejected Claims 9 and 13 under 35 U.S.C. 103(a) as being unpatentable over Radatti, U.S. Patent Application Publication 2002/0170052, in view of Delaney, U.S. Patent No. 6,374,289, in further view of Shostack, U.S. Patent No. 6,298,445.

Group #1: Claims 9 and 13

Appellant respectfully asserts that such claims are not met by the prior art for the reasons argued above with respect to Issue #6, Group #1.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue #8:

The Examiner has rejected Claims 10 and 14 under 35 U.S.C. 103(a) as being unpatentable over Radatti, U.S. Patent Application Publication 2002/0170052, in view of Delaney, U.S. Patent No. 6,374,289, in further view of Shostack, U.S. Patent No. 6,298,445, in further view of Verisign (Verisign Gets US Approval for 128-bit Key Certificates Export).

Group #1: Claims 10 and 14

Appellant respectfully asserts that such claims are not met by the prior art for the reasons argued above with respect to Issue #6, Group #1.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NA11P275_01.014.01).

Respectfully submitted,

By:  _____

Kevin J. Zilka

Reg. No. 41,429

Date: 5/30/06

Zilka-Kotab, P.C.

P.O. Box 721120

San Jose, California 95172-1120

Telephone: (408) 971-2573

Facsimile: (408) 971-4660